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EXAMINER

UBILES, MARIE C

ART UNIT PAPER NUMBER

2642

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/867,794

**Applicant(s)**

PERNU ET AL.

**Examiner**

Marie C. Ubiles

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-12, 16, 18-24, 27-29 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) -7, 10-12, 16, 18-24, 27-29 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3, 10-11, 16, 18-19, 27-28 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463).

As for claim 1, Gore et al. discloses a method for providing credit-checking data verification in a digital multiple-service network (*as seen on the use of a 5ESS switches, Fig. 2, elements 210 and 220*)(i.e. method for providing information in a digital multiple-service network); the system comprising a telecommunications network 200 (i.e. an exchange), a customer telephone 110 (i.e. a calling subscriber telecommunication terminal) connected to telecommunications network 200 via LEC 100 (i.e. first interface)(i.e. a calling subscriber telecommunication terminal connected to the digital multiple-service network via a first interface)(See *Fig. 2, elements 110 and 100 and Detailed Description, Col. 2, line 57 – Col. 3, line 2*), and an ISDN terminal 310 (i.e. called subscriber telecommunication terminal) connected to telecommunications network 200 via premise switching equipment 305 (i.e. second interface)(i.e. called subscriber telecommunication terminal connected to the digital multiple-service network via a second interface); a customer places a telephone call to business 300 via telephone 110 (i.e. after a call being initiated by a calling subscriber)(See *Detailed Description, Col. 4, lines 61-63*); the business 300 sends a FACILITY message to 4 ESS 220 (i.e. exchange) from ISDN terminal 310 requesting credit card validation

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number (i.e. number of said calling subscriber) from customer on telephone 110 (i.e. requesting calling subscriber information by sending from said called subscriber telecommunication terminal to said exchange a message requesting said calling subscriber information and comprising the number of said calling subscriber, said request being initiated by said called subscriber)(See *Detailed Description, Col. 4, lines 64-66 and Col. 5, lines 26-28*); the FACILITY message is received at 4 ESS 200 and an SS7 TCAP message is sent, by 4 ESS 200 to a credit checking data base 280 (i.e. server), the credit checking data base 280 is connected to 4 ESS 200 via path 21 (i.e. third interface) (i.e. in response to the received message, sending a query for said calling subscriber information from said exchange to a server implementing an information service, said server being connected to said multiple-service network via a third interface)(See *Detailed Description, Col. 5, lines 16-26*); credit checking data base 280 sends a TCAP message to 4 ESS 220 with the results of the validation (i.e. in response to the received query, sending said calling subscriber information from said server to said exchange); D-channel, Q.391, FACILITY message with the requested information is then sent, by 4 ESS 220 to business 300, the results are received at ISDN terminal 310 (i.e. in response to information, sending said calling subscriber telephone book information from said exchange to said called subscriber telecommunication terminal using channels reserved for signaling and a signaling protocol comprising a limited amount of information not belonging to the call)(See *Detailed Description, Col. 5, lines 30-43*).

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It can be seen that Gore et al. lacks the limitation specifying that information requested by the called subscriber to the exchange about the calling subscriber and sent from server into the exchange is that of telephone book information. It is well known in the art that a database with telephone numbers of calling subscribers can be connected to an exchange and that telephone book information can be sent from such database to a called subscriber through an exchange (as for example, Caller ID devices). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify, Gore's et al. system by further adding that requested and received information via the D-channel is that of telephone book information; thus in this manner the called subscriber can request the telephone book information of a calling party even if the called party is busy and/or active on the B-channel.

It may also be appreciated that the first and third interfaces disclosed by Gore et al. are not ISDN interfaces. However, the Examiner believes that implementation of such interfaces will be easily achieved on Gore's system, Gore et al. already teaches an ISDN interface (i.e. second ISDN interface) as read on the use of a "ISDN trunk 14" to connect the called party to the network (See Col. 3, line 27 through Col. 4, line 42). Further, it would have been obvious to one of ordinary skill in the art that both the calling party and the server will need some kind of ISDN interface (at 4 ESS 220) to interact with the "ISDN trunk 14" and business 300 of Gore et al.

Claim 18 is rejected for the same reasons as claim 1.

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As for claim 3, Gore et al. discloses the of information elements for transmitting between the ISDN endpoints, ISDN terminal 319 and 4 ESS 220 (i.e. wherein the calling subscriber information is transmitted in an information element comprising means for generating and sending messages in the called subscriber telecommunication terminal and in the exchange)(See *Detailed Description, Col. 5, lines 1-5*). It should be noted that while Gore et al. does not specify that information elements are use to transmit the information into the calling subscriber telecommunications terminal and the server, that the same technique can be duplicated into for these endpoints.

Claim 20 is rejected for the same reasons as claim 3.

As for claims 10-11, Gore et al. discloses that a FACILITY message is used to transmit a request from ISDN terminal 310 and 4 ESS 220, such a message is used to transmit information (i.e. wherein said message sent from said called subscriber telecommunication terminal to said exchange is a Facility message and wherein said message sent from said called subscriber telecommunication terminal to said exchange is an Information message)(See *Detailed Description, Col. 5, lines 1-9*).

Claims 27-28 are rejected for the same reasons as claims 10-11.

As for claims 16 and 33, the Examiner takes official notice that it is well know in the art that a menu can be used to activate different features from an ISDN terminal (See for example Jrejj et al. (US 6,292,548) provided herein as reference).

1. Claims 2, 4, 19 and 21 are rejected under 35 U.S.C 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of Wrede et al. (US 5,937,040).

As for claims 2 and 4, it can be seen that Gore et al. lacks the steps of transmitting the calling subscriber telephone book information in the form of a text message and by using UUS signaling.

Wrede et al. teaches a method in which a message is transmitted simultaneously as speech over a B-channel and as text file over the signaling or D-channel (See Summary of the Invention, Col. 2, lines 46-51). Wrede et al. further teaches "The conversion of the messages formats the information for the visual presentation at the display of the remote phone terminal. [...] referring to the ISDN environment, the formatting may be achieved by embedding the menu information into DISPLAY Information Elements (IEs) or into containers (i.e., envelopes) of user-to-user information compatible with D-channel transmission, so that digital character strings are sent for display in realtime at a remote ISDN display phone." (See Summary of the Invention, Col. 2, lines 44-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gore et al. method by transmitting the text file or service information using user-to-user signaling as taught by Wrede et al., so a user at a telecommunication terminal or remote ISDN display phone can read the service information from the terminal's display screen.

Claims 19 and 21 are rejected for the same reasons as claims 2 and 4.

2. Claims 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al (US. 5,313,463) in view of ETSI (European Telecommunications Standard Institute) (Draft prETS 300 716: February 1996).

As for claim 5, it can be seen that Gore et al. lacks the step of transmitting the calling subscriber telephone book information using USBS signaling.

ETSI teaches "The USBS provides the unrestricted transfer (without alteration) of user information, on the D-channel of user access, in a packetized manner over a virtual circuit between reference points via the basic and primary rate access." (See Scope, page 7, lines 13-15).

It is well known in the art that in a virtual circuit, when a user wishes to transmit information, he or she simply transmit the information (as no conventional dialing is needed), thus no setup and no disconnect operations are needed when data or service information is sent. It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Gore et al. method by transmitting the user or service information using USBS signaling as taught by the ETSI draft paper, providing the user the ability to transfer the aforementioned service information over a virtual circuit and therefore making possible for the information to be transferred to the telecommunications terminal in a rapid and cost-effective manner.

Claim 22 is rejected for the same reasons as claim 5.



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3. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of ETSI (European Telecommunications Standard Institute) (ETS 300 050: October 1991).

As for claim 6, it can be seen that Gore et al. lacks the step of the server distinguishing the telephone book information service to be provided via multiple subscriber numbering (MSN) and a number of terminal-specific identification numbers have been defined for the basic subscriber interface.

ETSI teaches "The Multiple Subscriber Number (MSN) supplementary service provides the possibility for assigning multiple numbers to a single public or private access. This allows e.g.: 1) a calling user to select, via the public network, one or multiple distinct terminals out of a multiple choice; 2) to identify the terminal to the network for the application of other supplementary services." (See Scope, page 7, lines 14-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Gore et al. method by distinctly identifying each telecommunications terminal via MSN as taught by the ETSI paper, so that the service information (or other supplementary services) requested by said terminal arrives to the terminal where the request is originated from (this reads on "to identify the terminal to the network for the application of other supplementary services").

Claim 23 is rejected for the same reasons as claim 6.

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4. Claims 7 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of Newton (Newton's Telecom Dictionary, March 1998).

As for claim 7, it can be seen that Gore et al. lacks the step of the server distinguishing the telephone book information service to be provided via subaddressing.

Newton teaches "[subaddressing] a name for an ISDN service which enables many different type of terminals [...] to be connected to the ISDN user interface and uniquely identified during a call request." (See Newton's Telecom Dictionary, March 1998, page 683).

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Gore et al. method by distinctly identifying each telecommunications terminal via subaddressing as taught by Newton, so that the service information (or other supplementary services) requested by said terminal arrives to the terminal where the request is originated from (this reads on "[terminal] uniquely identified during a call request").

Claim 24 is rejected for the same reasons as claim 7.

5. Claims 12 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of Masuda (4,709,387).

As for claim 12, it can be seen that Gore lacks the step of storing the calling subscriber telephone book information received by the called subscriber telecommunication terminal in said called subscriber telecommunication terminal.

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Masuda teaches "A telephone having a memory for storing telephone numbers and proper names related to each telephone number, and input means for introducing said telephone numbers and proper names into said memory, an improvement in said input comprising: keyboard means including a plurality of keys consisting only of numeric keys and function keys; display means for displaying information input by said keys; said memory having stored therein alphabetic character data capable of generating all characters of an alphabet from which said proper names shall be formed..." (See Claim 1, lines 28-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the aforementioned method by providing a telecommunications terminal with capabilities for storing telephone numbers or telephone book information within memory of said terminal, therefore the user will not have to request the exchange/server to provide service information related to telephone book information that is used constantly-used by said user and that this information is readily access by said user.

Claim 29 is rejected for the same reasons as claim 12.

### ***Response to Arguments***

6. The Examiner, on the rejection above, addressed the arguments brought by Applicant on the After Final dated 6/23/2004.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie C. Ubiles whose telephone number is (703) 305-0684. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marie C. Ubiles  
December 22, 2004.



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